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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,868	12/12/2001	Michael D. Hooven	HOOV 117	7290
26568	7590	05/19/2006	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			ROLLINS, ROSILAND STACIE	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/015,868	HOOVEN, MICHAEL D.
	<b>Examiner</b> Rosiland S. Rollins	<b>Art Unit</b> 3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 23 February 2006.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 50-58 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 50-58 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/23/06

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date.       .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other:       .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately disclose a tissue ablation apparatus as claimed that includes at least one of the conductive members defining an interior lumen and further comprises at least one temperature sensor associated with at least one jaw.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 50-56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac (US H1745) in view of Baker (US 6126658).**

**Regarding claim 50, in figure 5 Paraschac discloses a cardiac tissue ablation apparatus comprising first (116) and second jaws (117), the jaws being relatively**

moveable between open and closed positions, respectively, receive and compress cardiac tissue there between; each jaw having a clamping surface (**see figure**) with a width and an elongated electrically conductive member (**118 & 119**) for jaws, the conductive members of the jaws being in face-to-face relation and connectible to a bipolar energy power source so as to be of opposite polarity when so connected for providing an electrical current through tissue between the jaws, the conductive members each having a tissue contacting portion (**as illustrated**), which portion has a width that is less than the width of the clamping surface of its associated jaw

Paraschac teaches all of the limitations of the claims except the apparatus further comprising at least one temperature sensor associated with at least one jaw and disposed to sense the temperature of cardiac tissue at a location laterally spaced from the tissue contacting portions of the conductive members.

Baker discloses an electrosurgical device and teaches in column 8 lines 5-19 that it is old and well known in the art to associate at least one temperature sensor with at least one jaw (**figure 5**). Therefore, it would have been obvious to add a temperature sensor to the Paraschac device as taught by Baker, so that the temperature of the tissue or device can be measured as a means of monitoring and controlling the amount of energy delivered to device. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to laterally space the temperature sensor from the tissue contacting portions of the conductive members, since it has been held that rearranging parts of an invention involves only routine skill in the art.

**Regarding claim 52,** it would have been obvious to the artisan to dispose the temperature sensor proximal to the conductive member and electrically isolated it therefrom, since it has been held that rearranging parts of an invention involves only routine skill in the art.

**Regarding claim 53,** Baker teaches that the temperature sensor is supported by one of the jaws.

**Regarding claim 54,** Paraschac teaches that each tissue contacting portion has a width that is less than or equal to about one-third the width of the associated clamping surface.

**Regarding claim 55,** it would have been obvious to the artisan to provide conductive members that are between approximately 3 to 8 cm in length and the portion of the conductive members is between approximately 0.12 to 0.6 mm in width, since it has been held that discovering the optimum size involves only routine skill in the art.

**Regarding claim 56,** Paraschac teaches that each conductive member is generally centrally located relative to the associated clamping surface.

**Regarding claim 58,** Paraschac discloses a portion of the clamping surface disposed on each side of the conductive member.

**Claims 50-56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates (US 5688270) in view of Baker (US 6126658).**

In figures 22-24 Yates disclose a cardiac tissue ablation apparatus comprising first (532) and second jaws (534), the jaws being relatively moveable between open and closed positions, respectively, receive and compress cardiac tissue there between;

each jaw having a clamping surface (**see figure**) with a width and an elongated electrically conductive member (**527a & 528b**) for jaws, the conductive members of the jaws being in face-to-face relation and connectible to a bipolar energy power source so as to be of opposite polarity when so connected for providing an electrical current through tissue between the jaws, the conductive members each having a tissue contacting portion (**as illustrated**), which portion has a width that is less than the width of the clamping surface of its associated jaw.

Yates teach all of the limitations of the claims except the apparatus further comprising at least one temperature sensor associated with at least one jaw and disposed to sense the temperature of cardiac tissue within the vicinity of the jaws. Baker discloses an electrosurgical device and teaches in column 8 lines 5-19 that it is old and well known in the art to associate at least one temperature sensor with at least one jaw (**figure 5**). Therefore, it would have been obvious to add a temperature sensor to the Yates device as taught by Baker, so that the temperature of the tissue or device can be measured as a means of monitoring and controlling the amount of energy delivered to device. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to laterally space the temperature sensor from the tissue contacting portions of the conductive members, since it has been held that rearranging parts of an invention involves only routine skill in the art.

***Claim Rejections - 35 USC § 103***

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac and Baker combined further in view of Francischelli (US 2003/0073991).**

Paraschac and Baker combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 2a-g, Francischelli disclose an electrosurgical device and teach that it is old and well known in the art to provide a conductive member (102/104) that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates and Baker combined further in view of Francischelli (US 2003/0073991).**

Yates and Baker combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 2a-g, Francischelli disclose an electrosurgical device and teach that it is old and well known in the art to provide a conductive member (102/104) that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to

an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac and Baker combined further in view of Mulier (US 6096037).**

Paraschac and Baker combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 4 & 5, Mulier discloses an electrosurgical device and teach that it is old and well known in the art to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates and Baker combined further in view of Mulier (US 6096037).**

Paraschac and Baker combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 4 & 5, Mulier discloses an electrosurgical device and teach that it is old and well known in the art to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to

provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

***Response to Arguments***

Applicant's arguments filed 2/23/06 have been fully considered but they are not persuasive. Applicant argues that the temperature sensors of Baker are not disposed to sense the temperature of cardiac tissue at a location laterally spaced from the tissue contacting portions of the conductive members but, in contrast to claim 50, to measure temperature of tissue adjacent to the active electrodes during a vessel welding operation. As pointed out in the above rejections, relocating the temperature sensor merely involves routine skill in the art and because of this the claimed limitations have been met by the prior art.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosiland S Rollins  
Primary Examiner  
Art Unit 3739